

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	)	
	)	
Inventor: Lee Anne Kowalski	)	Examiner: Henry W. Orr
	)	
Serial #: 09/928,599	)	Group Art Unit: 2176
	)	
Filed: August 13, 2001	)	Appeal No.: _____
	)	
Title: METHOD AND SYSTEM FOR	)	
IDENTIFYING AND DISTINGUISHING	)	
WORDS CONTAINED WITHIN AN	)	
ELECTRONIC MESSAGE IN ORDER TO	)	
<u>CONVEY SIGNIFICANCE</u>	)	

**BRIEF OF APPELLANT**

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR §41.37, Appellant's attorney hereby submits the Brief of Appellant on appeal from the final rejection in the above-identified application, as set forth in the Office Action dated September 19, 2008.

Please charge the amount of \$540.00 to cover the required fee for filing this Appeal Brief as set forth under 37 C.F.R. §41.37(a) (2) and 37 C.F.R. §41.20(b) (2) to Deposit Account 09-0460 of I.B.M. Corporation, the assignee of the present invention. In addition, the Office is authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 09-0460.

I. REAL PARTY IN INTEREST

The real party in interest is I.B.M. Corporation, the assignee of the present application.

## II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

## III. STATUS OF CLAIMS

Claims 1, 4-23, 26-45 and 48-66 are pending in the application.

Claims 2-3, 24-25 and 46-47 have been canceled from the application.

Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60, and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick et al., “Special Edition Using Microsoft Outlook 2000,” Que Publishing, May 12, 1999 (Padwick-Outlook 2000) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen).

Claims 17-18, 39-40, and 61-62 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick et al., “Special Edition Using Microsoft Outlook 2000,” Que Publishing, May 12, 1999 (Padwick-Outlook 2000) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen), and further in view of Larson et al., U.S. Patent No. 5,825,854 (Larson).

Claims 1, 4-23, 26-45 and 48-66 are being appealed.

## IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final Office Action.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter can be found in the Applicant’s specification as filed as shown below:

<b>Claim Elements</b>	<b>Support in Specification</b>
1. A computer-implemented method for identifying and distinguishing words contained within an electronic message, comprising the steps of:	Page 4, lines 11-21; Page 9, lines 9-21 referring to 102, 108 and 110 in FIG. 1.
(a) creating and reading electronic messages in an electronic messaging application, executed by a computer, wherein the	Page 5, lines 1-7; Page 6, line 21 – page 7, line 6; Page 11, line 1 – page 12, line 14, referring to

<b>Claim Elements</b>	<b>Support in Specification</b>
electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the steps of:	200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry; and	Page 4, lines 16-20; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
(2) making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.	Page 4, lines 16-20; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
4. The method of claim 1, wherein the significant terms are determined based upon a reader profile wherein the electronic message is altered when received.	Page 12, lines 4-14.
5. The method of claim 1, wherein the significant terms are determined based upon an author profile wherein the electronic message is altered when authored.	Page 12, lines 4-14.

<b>Claim Elements</b>	<b>Support in Specification</b>
6. The method of claim 1, wherein the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received.	Page 12, lines 4-14.
7. The method of claim 1, wherein the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored.	Page 12, lines 4-14.
8. The method of claim 1, further comprising the step of collecting and storing significant terms in the online registry.	Page 5, lines 1-4; Page 11, line 7-8, referring to 202 in FIG. 2; Page 11, line 18-19, referring to 302 in FIG. 3; Page 12, lines 19-21, referring to 402, 404 and 406 in FIG. 4.
9. The method of claim 8, wherein the step of collecting and storing comprises a user selecting significant terms.	Page 14, lines 3-9, referring to 402 in FIG. 4.
10. The method of claim 8, wherein the step of collecting and storing comprises importing significant terms.	Page 14, lines 3-9, referring to 402 in FIG. 4.
11. The method of claim 10, wherein significant terms are imported from an address book.	Page 14, lines 3-9, referring to 402 in FIG. 4.

<b>Claim Elements</b>	<b>Support in Specification</b>
12. The method of claim 10, wherein significant terms are imported from a database.	Page 14, lines 3-9, referring to 402 in FIG. 4.
13. The method of claim 1, wherein the significant terms comprise names of people, product terms or key words in a user's field.	Page 14, line 18 – page 15, line 4.
14. The method of claim 1, wherein making alterations to the electronic message comprises making the matched message terms a different color.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
15. The method of claim 1, wherein making alterations to the electronic message comprises making the matched message terms a different font effect.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
16. The method of claim 1, wherein making alterations to the electronic message comprises making the matched message terms a different font type.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 14; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
17. The method of claim 1, wherein making alterations to the electronic message	Page 13, lines 6-11, referring to 414 in FIG. 14.

<b>Claim Elements</b>	<b>Support in Specification</b>
comprises inserting an object into the electronic message near the matched message term.	
18. The method of claim 17, wherein the object comprises an image, a sound file, an icon, a link or a video.	Page 13, lines 6-11, referring to 414 in FIG. 14.
19. The method of claim 1, wherein making alterations to the matched message terms is performed according to a user setting.	Page 13, line 12 – page 14, line 2.
20. The method of claim 19, wherein the significant terms are categorized and the user setting is based upon a category of the significant term.	Page 13, line 12 – page 14, line 2.
21. The method of claim 1, further comprising the step of displaying the electronic message if the end of the electronic message has been reached.	Page 11, lines 14-16, referring to 204, 212, and 214 in FIG. 2; Page 11, line 22 – page 12, line 3, referring to 304, 310 and 312 in FIG. 3.
22. The method of claim 1, wherein the making step further comprises the step of querying a user before making alterations to the electronic message.	Page 8, lines 5-7; Page 11, lines 11-12, referring to 208 in FIG. 2; Page 13, lines 3-5, referring to FIG. 4.
23. A computer-implemented apparatus for identifying and distinguishing words	Page 4, lines 11-21; Page 9, lines 9-21 referring to 102, 108 and

<b>Claim Elements</b>	<b>Support in Specification</b>
contained within an electronic message, comprising:	110 in FIG. 1.
(a) an electronic messaging application, executed by a computer, for creating and reading electronic messages, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the functions of:	Page 5, lines 1-7; Page 6, line 21 – page 7, line 6; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
(1) an electronic message processor for comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match significant terms stored in the online registry; and	Page 4, lines 16-20; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
(2) an electronic message editor for making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.	Page 4, lines 16-20; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
26. The apparatus of claim 23, wherein the significant terms are determined based upon a	Page 12, lines 4-14.

<b>Claim Elements</b>	<b>Support in Specification</b>
reader profile wherein the electronic message is altered when received.	
27. The apparatus of claim 23, wherein the significant terms are determined based upon an author profile wherein the electronic message is altered when authored.	Page 12, lines 4-14.
28. The apparatus of claim 23, wherein the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received.	Page 12, lines 4-14.
29. The apparatus of claim 23, wherein the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored.	Page 12, lines 4-14.
30. The apparatus of claim 23, further comprising a term collection module for collecting and storing the significant terms in the online registry.	Page 5, lines 1-4; Page 11, line 7-8, referring to 202 in FIG. 2; Page 11, line 18-19, referring to 302 in FIG. 3; Page 12, lines 19-21, referring to 402, 404 and 406 in FIG. 4.
31. The apparatus of claim 30, wherein collecting and storing comprises a user selecting significant terms.	Page 14, lines 3-9, referring to 402 in FIG. 4.



<b>Claim Elements</b>	<b>Support in Specification</b>
32. The apparatus of claim 30, wherein collecting and storing comprises importing significant terms.	Page 14, lines 3-9, referring to 402 in FIG. 4.
33. The apparatus of claim 32, wherein significant terms are imported from an address book.	Page 14, lines 3-9, referring to 402 in FIG. 4.
34. The apparatus of claim 32, wherein significant terms are imported from a database.	Page 14, lines 3-9, referring to 402 in FIG. 4.
35. The apparatus of claim 23, wherein the significant terms comprise names of people, product terms or key words in a user's field.	Page 14, line 18 – page 15, line 4.
36. The apparatus of claim 23, wherein making alterations to the electronic message comprises making the matched message terms a different color.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
37. The apparatus of claim 23, wherein making alterations to the electronic message comprises making the matched message terms a different font effect.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
38. The apparatus of claim 23, wherein	Page 7, lines 14-21;

<b>Claim Elements</b>	<b>Support in Specification</b>
making alterations to the electronic message comprises making the matched message terms a different font type.	Page 13, lines 6-11, referring to 414 in FIG. 14; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
39. The apparatus of claim 23, wherein making alterations to the electronic message comprises inserting an object near the matched message term.	Page 13, lines 6-11, referring to 414 in FIG. 14.
40. The apparatus of claim 39, wherein the object comprises an image, a sound file, an icon, a link or a video.	Page 13, lines 6-11, referring to 414 in FIG. 14.
41. The apparatus of claim 23, wherein making alterations to the electronic message is performed according to a user setting.	Page 13, line 12 – page 14, line 2.
42. The apparatus of claim 41, wherein the significant terms are categorized and the user setting is based upon a category of the significant term.	Page 13, line 12 – page 14, line 2.
43. The apparatus of claim 23, further comprising the step of displaying the electronic message if the end of the electronic message has been reached.	Page 11, lines 14-16, referring to 204, 212, and 214 in FIG. 2; Page 11, line 22 – page 12, line 3, referring to 304, 310 and 312 in FIG. 3.
44. The apparatus of claim 23, wherein the	Page 8, lines 5-7;

<b>Claim Elements</b>	<b>Support in Specification</b>
electronic message editor further comprises means for querying a user before making alterations to the electronic message.	Page 11, lines 11-12, referring to 208 in FIG. 2; Page 13, lines 3-5, referring to FIG. 4.
45. An article of manufacture comprising a program storage device embodying instructions that, when read and executed by a computer, result in the computer performing a computer-implemented method for identifying and distinguishing words contained within an electronic message, comprising the steps of:	Page 4, lines 11-21; Page 9, lines 9-21 referring to 102, 108 and 110 in FIG. 1.
(a) creating and reading electronic messages in an electronic messaging application, executed by the computer, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the steps of:	Page 5, lines 1-7; Page 6, line 21 – page 7, line 6; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry; and	Page 4, lines 16-20; Page 11, line 1 – page 12, line 14, referring to 200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
(2) making alterations to the electronic message to identify the matched message	Page 4, lines 16-20; Page 11, line 1 – page 12, line 14, referring to

<b>Claim Elements</b>	<b>Support in Specification</b>
terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.	200-214 in FIG. 2 and 300-312 in FIG. 3; Page 12, line 17 – page 13, line 5, referring to 400-414 in FIG. 4.
48. The article of claim 45, wherein the significant terms are determined based upon a reader profile wherein the electronic message is altered when received.	Page 12, lines 4-14.
49. The article of claim 45, wherein the significant terms are determined based upon an author profile wherein the electronic message is altered when authored.	Page 12, lines 4-14.
50. The article of claim 45, wherein the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received.	Page 12, lines 4-14.
51. The article of claim 45, wherein the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored.	Page 12, lines 4-14.
52. The article of claim 45, further comprising the step of collecting and storing significant terms in the online registry.	Page 5, lines 1-4; Page 11, line 7-8, referring to 202 in FIG. 2; Page 11, line 18-19, referring to 302 in FIG.

<b>Claim Elements</b>	<b>Support in Specification</b>
	3; Page 12, lines 19-21, referring to 402, 404 and 406 in FIG. 4.
53. The article of claim 52, wherein the step of collecting and storing comprises a user selecting significant terms.	Page 14, lines 3-9, referring to 402 in FIG. 4.
54. The article of claim 52, wherein the step of collecting and storing comprises importing significant terms.	Page 14, lines 3-9, referring to 402 in FIG. 4.
55. The article of claim 54, wherein significant terms are imported from an address book.	Page 14, lines 3-9, referring to 402 in FIG. 4.
56. The article of claim 54, wherein significant terms are imported from a database.	Page 14, lines 3-9, referring to 402 in FIG. 4.
57. The article of claim 45, wherein the significant terms comprise names of people, product terms or key words in a user's field.	Page 14, line 18 – page 15, line 4.
58. The article of claim 45, wherein making alterations to the electronic message comprises making the matched message terms a different color.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.

<b>Claim Elements</b>	<b>Support in Specification</b>
59. The article of claim 45, wherein making alterations to the electronic message comprises making the matched message terms a different font effect.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
60. The article of claim 45, wherein making alterations to the electronic message comprises making the matched message terms a different font type.	Page 7, lines 14-21; Page 13, lines 6-11, referring to 414 in FIG. 4; Page 15, lines 5-15; Page 15, line 16 – page 16, line 1.
61. The article of claim 45, wherein making alterations to the electronic message comprises inserting an object near the matched message term.	Page 13, lines 6-11, referring to 414 in FIG. 14.
62. The article of claim 61, wherein the object comprises an image, a sound file, an icon, a link or a video.	Page 13, lines 6-11, referring to 414 in FIG. 14.
63. The article of claim 45, wherein making alterations to the electronic message is performed according to a user setting.	Page 13, line 12 – page 14, line 2.
64. The article of claim 63, wherein the significant terms are categorized and the user setting is based upon a category of the	Page 13, line 12 – page 14, line 2.

Claim Elements	Support in Specification
significant term.	
65. The article of claim 45, further comprising the step of displaying the electronic message if the end of the electronic message has been reached.	Page 11, lines 14-16, referring to 204, 212, and 214 in FIG. 2; Page 11, line 22 – page 12, line 3, referring to 304, 310 and 312 in FIG. 3.
66. The article of claim 45, wherein the making step further comprises the step of querying a user before making alterations to the electronic message.	Page 8, lines 5-7; Page 11, lines 11-12, referring to 208 in FIG. 2; Page 13, lines 3-5, referring to FIG. 4.

#### VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60, and 63-66 stand rejected under 35 U.S.C. §103(a) as being obvious over Padwick et al., “Special Edition Using Microsoft Outlook 2000 ,” Que Publishing, May 12, 1999 (Padwick-Outlook 2000 ) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen).

2. Claims 17-18, 39-40, and 61-62 stand rejected under 35 U.S.C. §103(a) as being obvious over Padwick et al., “Special Edition Using Microsoft Outlook 2000 ,” Que Publishing, May 12, 1999 (Padwick-Outlook 2000 ) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen) , and further in view of Larson et al., U.S. Patent No. 5,825,854 (Larson).

#### VII. ARGUMENT

##### A. The Office Action rejections

In paragraphs (7) -(8) of the Office Action, claims 1, 4-16, 19-23, 26-38, 41-45, 48-60, and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick et al., “Special Edition Using Microsoft Outlook 2000 ,” Que Publishing, May 12, 1999 (Padwick-Outlook 2000 ) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen). On page (20) , paragraph (8) of the Office Action, claims 17-18, 39-40, and 61-62 were rejected under 35

U.S.C. §103(a) as being unpatentable over Padwick in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854 (Larson) .

Appellant's attorney respectfully traverses these rejections.

B. Arguments directed to the first grounds for rejection: Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60, and 63-66 stand rejected under 35 U.S.C. §103(a) as being obvious over Padwick et al., "Special Edition Using Microsoft Outlook 2000," Que Publishing, May 12, 1999 (Padwick-Outlook 2000 ) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen).

1. Independent claims 1, 23 and 45

Appellant's attorney notes that the rejections based on Padwick-Outlook 2000 and Chen were previously presented in an Office Action dated November 29, 2005, and were previously overcome by the response filed by Appellant's attorney dated February 27, 2006, as acknowledged by the rejections' absence in an Office Action dated April 25, 2006. Nonetheless, the Office Action dated April 15, 2008 reintroduced these rejections. In the Office Action dated September 19, 2008, however, the Examiner asserted that Padwick-Outlook 2000 was referenced on page 29 of the Office Action dated April 15, 2008, but Appellant's attorney submits that this reference is clearly to Padwick-Outlook 2002, not Padwick-Outlook 2000 .

Consequently, Appellant's attorney again traverses these rejections. Appellant's attorney submits that the claimed invention distinguishes over the Padwick-Outlook 2000 and Chen references. Specifically, the combination of Padwick-Outlook 2000 and Chen references does not teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by an electronic messaging application when the electronic message is authored by its originator or received by its recipient.

For example, the Office Action acknowledges that Padwick-Outlook 2000 fails to disclose making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader. Nonetheless, the Office Action asserts that Chen teaches these limitations. Further, the Office Action asserts that Chen teaches altering the electronic message when it is authored or received.



However, Chen explicitly states that emails or other documents must be imported into its document management system. See, col. 3, 37-59 of Chen. Moreover, Chen's document management system is not an electronic messaging application. Consequently, Chen does not make the alterations when the electronic message is authored by its originator or received by its recipient. Instead, Chen teaches functions that are performed only when the email has been imported into the document management system.

Larson fails to overcome the deficiencies of Padwick-Outlook 2000 and Chen. Recall that Larson was cited only against dependent claims 17-18, 39-40, and 61-62, and only for teaching a telephone access system that inserts an audio file at a highlighted term of an electronic message.

Thus, , even when combined, the references do not teach or suggest all the limitations of Appellant's claims. Moreover, the various elements of Appellant's claimed invention together provide operational advantages over the references. In addition, Appellant's invention solves problems not recognized by the references.

As a result, Appellant's attorney submits that independent claims 1, 23 and 45 are allowable over Padwick-Outlook 2000 and Chen. Further, dependent claims 4-22, 26-44 and 48-66 are submitted to be allowable over Padwick-Outlook 2000 , Chen and/or Larson in the same manner, because they are dependent on independent claims 1, 23, and 45, respectively, and thus, contain all the limitations of the independent claims. In addition, dependent claims 4-22, 26-44 and 48-66 recite additional novel elements not shown by Padwick-Outlook 2000 , Chen and/or Larson.

## 2. Dependent claims 4, 26 and 48

With regard to dependent claims 4, 26 and 48, which recite that "the significant terms are determined based upon a reader profile wherein the electronic message is altered when received," the Office Action cites Padwick-Outlook 2000 as teaching a Rules Wizard that allows a user to create rules for processing messages and Chen as disclosing a message that is altered when received. Appellant's attorney submits that these functions are performed independently by the references, and that, even when combined, a rule performed by Padwick-Outlook 2000 would not cause Chen to alter a message. Thus, , the combination of Padwick-Outlook 2000 and Chen do not teach or suggest these claims.

3. Dependent claims 5, 27 and 49

With regard to dependent claims 5, 27 and 49, which recite that “the significant terms are determined based upon an author profile wherein the electronic message is altered when authored,” the Office Action cites Padwick-Outlook 2000 as teaching a Rules Wizard that allows a user to create rules for processing messages and Chen as disclosing a message that is altered when authored. Appellant’s attorney submits that these functions are performed independently by the references, and that, even when combined, a rule performed by Padwick-Outlook 2000 would not cause Chen to alter a message. Thus, , the combination of Padwick-Outlook 2000 and Chen do not teach or suggest these claims.

4. Dependent claims 6, 28 and 50

With regard to dependent claims 6, 28 and 50, which recite that “the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received,” the Office Action cites Chen as disclosing that a document management system highlights keywords within a message. Appellant’s attorney submits that nowhere does Chen refer to a reader profile or the alteration of a message within an electronic messaging application when the message is received. Thus, Chen does not teach or suggest these claims.

5. Dependent claims 7, 29 and 51

With regard to dependent claims 7, 29 and 51, which recite that “the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored,” the Office Action cites Chen as disclosing that a document management system highlights keywords within a message. Appellant’s attorney submits that nowhere does Chen refer to an author profile or the alteration of a message within an electronic messaging application when the message is authored. Thus, Chen does not teach or suggest these claims.

6. Dependent claims 8-16, 19-22, 30-38, 41-44, 52-60 and 63-66

With regard to dependent claims 8-16, 19-22, 30-38, 41-44, 52-60 and 63-66, these claims stand or fall with independent claims 1, 23 and 45, respectively.

- C. Arguments directed to the second grounds for rejection: Claims 17-18, 39-40, and 61-62 stand rejected under 35 U.S.C. §103(a) as being obvious over Padwick et al., “Special Edition Using Microsoft Outlook 2000 ,” Que Publishing, May 12, 1999 (Padwick-Outlook 2000 ) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen) , and further in view of Larson et al., U.S. Patent No. 5,825,854 (Larson).

1. Dependent claims 17, 39 and 61

With regard to dependent claims 17, 39 and 61, which recite that “making alterations to the electronic message comprises inserting an object into the electronic message near the matched message term,” the Office Action cites Larson as disclosing that a telephone access system that inserts an audio file at a highlighted term in an electronic message. Appellant’s attorney notes that nowhere does Larson refer to inserting an audio file at a highlighted term in an electronic message. Thus, Larson does not teach or suggest these claims.

2. Dependent claims 18, 40, and 62

With regard to dependent claims 18, 40, and 62, these claims stand or fall with independent claims 17, 39 and 61, respectively.

## VIII. CONCLUSION

In light of the above arguments, Appellant’s attorney respectfully submits that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellant’s claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103.

As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

Respectfully submitted,

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Attorneys for Appellant

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Date: February 19, 2009

GHG/

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## **CLAIMS APPENDIX**

1. (PREVIOUSLY PRESENTED) A computer-implemented method for identifying and distinguishing words contained within an electronic message, comprising the steps of:

(a) creating and reading electronic messages in an electronic messaging application, executed by a computer, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the steps of:

(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry; and

(2) making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.

2. (CANCELED)

3. (CANCELED)

4. (PREVIOUSLY PRESENTED) The method of claim 1, wherein the significant terms are determined based upon a reader profile wherein the electronic message is altered when received.

5. (PREVIOUSLY PRESENTED) The method of claim 1, wherein the significant terms are determined based upon an author profile wherein the electronic message is altered when authored.

6. (PREVIOUSLY PRESENTED) The method of claim 1, wherein the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received.

7. (PREVIOUSLY PRESENTED) The method of claim 1, wherein the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored.

8. (ORIGINAL) The method of claim 1, further comprising the step of collecting and storing significant terms in the online registry.

9. (ORIGINAL) The method of claim 8, wherein the step of collecting and storing comprises a user selecting significant terms.

10. (ORIGINAL) The method of claim 8, wherein the step of collecting and storing comprises importing significant terms.

11. (ORIGINAL) The method of claim 10, wherein significant terms are imported from an address book.

12. (ORIGINAL) The method of claim 10, wherein significant terms are imported from a database.

13. (PREVIOUSLY PRESENTED) The method of claim 1, wherein the significant terms comprise names of people, product terms or key words in a user's field.

14. (PREVIOUSLY PRESENTED) The method of claim 1, wherein making alterations to the electronic message comprises making the matched message terms a different color.

15. (PREVIOUSLY PRESENTED) The method of claim 1, wherein making alterations to the electronic message comprises making the matched message terms a different font effect.

16. (PREVIOUSLY PRESENTED) The method of claim 1, wherein making alterations to the electronic message comprises making the matched message terms a different font type.

17. (PREVIOUSLY PRESENTED) The method of claim 1, wherein making alterations to the electronic message comprises inserting an object into the electronic message near the matched message term.

18. (PREVIOUSLY PRESENTED) The method of claim 17, wherein the object comprises an image, a sound file, an icon, a link or a video.

19. (PREVIOUSLY PRESENTED) The method of claim 1, wherein making alterations to the matched message terms is performed according to a user setting.

20. (ORIGINAL) The method of claim 19, wherein the significant terms are categorized and the user setting is based upon a category of the significant term.

21. (ORIGINAL) The method of claim 1, further comprising the step of displaying the electronic message if the end of the electronic message has been reached.

22. (PREVIOUSLY PRESENTED) The method of claim 1, wherein the making step further comprises the step of querying a user before making alterations to the electronic message.

23. (PREVIOUSLY PRESENTED) A computer-implemented apparatus for identifying and distinguishing words contained within an electronic message, comprising:

(a) an electronic messaging application, executed by a computer, for creating and reading electronic messages, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the functions of:

(1) an electronic message processor for comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match significant terms stored in the online registry; and

(2) an electronic message editor for making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.

24. (CANCELED)

25. (CANCELED)

26. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein the significant terms are determined based upon a reader profile wherein the electronic message is altered when received.

27. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein the significant terms are determined based upon an author profile wherein the electronic message is altered when authored.

28. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received.

29. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored.

30. (ORIGINAL) The apparatus of claim 23, further comprising a term collection module for collecting and storing the significant terms in the online registry.

31. (ORIGINAL) The apparatus of claim 30, wherein collecting and storing comprises a user selecting significant terms.



32. (ORIGINAL) The apparatus of claim 30, wherein collecting and storing comprises importing significant terms.

33. (ORIGINAL) The apparatus of claim 32, wherein significant terms are imported from an address book.

34. (ORIGINAL) The apparatus of claim 32, wherein significant terms are imported from a database.

35. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein the significant terms comprise names of people, product terms or key words in a user's field.

36. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein making alterations to the electronic message comprises making the matched message terms a different color.

37. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein making alterations to the electronic message comprises making the matched message terms a different font effect.

38. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein making alterations to the electronic message comprises making the matched message terms a different font type.

39. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein making alterations to the electronic message comprises inserting an object near the matched message term.

40. (PREVIOUSLY PRESENTED) The apparatus of claim 39, wherein the object comprises an image, a sound file, an icon, a link or a video.

41. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein making alterations to the electronic message is performed according to a user setting.

42. (ORIGINAL) The apparatus of claim 41, wherein the significant terms are categorized and the user setting is based upon a category of the significant term.

43. (ORIGINAL) The apparatus of claim 23, further comprising the step of displaying the electronic message if the end of the electronic message has been reached.

44. (PREVIOUSLY PRESENTED) The apparatus of claim 23, wherein the electronic message editor further comprises means for querying a user before making alterations to the electronic message.

45. (PREVIOUSLY PRESENTED) An article of manufacture comprising a program storage device embodying instructions that, when read and executed by a computer, result in the computer performing a computer-implemented method for identifying and distinguishing words contained within an electronic message, comprising the steps of:

(a) creating and reading electronic messages in an electronic messaging application, executed by the computer, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the steps of:

(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry; and

(2) making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.

46. (CANCELED)

47. (CANCELED)

48. (PREVIOUSLY PRESENTED) The article of claim 45, wherein the significant terms are determined based upon a reader profile wherein the electronic message is altered when received.

49. (PREVIOUSLY PRESENTED) The article of claim 45, wherein the significant terms are determined based upon an author profile wherein the electronic message is altered when authored.

50. (PREVIOUSLY PRESENTED) The article of claim 45, wherein the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received.

51. (PREVIOUSLY PRESENTED) The article of claim 45, wherein the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored.

52. (ORIGINAL) The article of claim 45, further comprising the step of collecting and storing significant terms in the online registry.

53. (ORIGINAL) The article of claim 52, wherein the step of collecting and storing comprises a user selecting significant terms.

54. (ORIGINAL) The article of claim 52, wherein the step of collecting and storing comprises importing significant terms.

55. (ORIGINAL) The article of claim 54, wherein significant terms are imported from an address book.

56. (ORIGINAL) The article of claim 54, wherein significant terms are imported from a database.

57. (PREVIOUSLY PRESENTED) The article of claim 45, wherein the significant terms comprise names of people, product terms or key words in a user's field.

58. (PREVIOUSLY PRESENTED) The article of claim 45, wherein making alterations to the electronic message comprises making the matched message terms a different color.

59. (PREVIOUSLY PRESENTED) The article of claim 45, wherein making alterations to the electronic message comprises making the matched message terms a different font effect.

60. (PREVIOUSLY PRESENTED) The article of claim 45, wherein making alterations to the electronic message comprises making the matched message terms a different font type.

61. (PREVIOUSLY PRESENTED) The article of claim 45, wherein making alterations to the electronic message comprises inserting an object near the matched message term.

62. (PREVIOUSLY PRESENTED) The article of claim 61, wherein the object comprises an image, a sound file, an icon, a link or a video.

63. (PREVIOUSLY PRESENTED) The article of claim 45, wherein making alterations to the electronic message is performed according to a user setting.

64. (ORIGINAL) The article of claim 63, wherein the significant terms are categorized and the user setting is based upon a category of the significant term.

65. (ORIGINAL) The article of claim 45, further comprising the step of displaying the electronic message if the end of the electronic message has been reached.

66. (ORIGINAL) The article of claim 45, wherein the making step further comprises the step of querying a user before making alterations to the electronic message.

## **EVIDENCE APPENDIX**

None.

## **RELATED PROCEEDINGS APPENDIX**

None.